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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,301	01/26/2007	Fu-Yue Zeng	AREN-065 (65.US2.PCT)	3381
65643	7590	09/15/2010		
Arena Pharmaceuticals, Inc. Bozicevic, Field & Francis LLP 1900 University Avenue, Suite 200 East Palo Alto, CA 94303			EXAMINER PAK, MICHAEL D	
			ART UNIT 1646	PAPER NUMBER
			MAIL DATE 09/15/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,301

Applicant(s)

ZENG ET AL.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 12, 23-29, 31, 36, 52-61, 63-68, 70, 75, 91, 92 and 122-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 12, 23-29, 31, 36, 52-61, 63-68, 70, 75, 91-92, 122-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment filed June 24, 2010 has been entered.
2. Applicant's arguments filed June 24, 2010, have been fully considered but they are not found persuasive.
3. Claims 6, 8-11, 13-22, 30, 32-35, 37-51, 62, 69, 71-74, 76-90, and 93-121 are cancelled. Claims 1-5, 7, 12, 23-29, 31, 36, 52-61, 63-68, 70, 75, 91-92 and 122-157 are examined below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5, 7, 12, 23-29, 31, 36, 52-61, 63-68, 70, 75, 91-92 and 122-157 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims encompass the terms "wherein said method does not comprise immunoprecipitating said first and second polypeptides" which is new matter not disclosed in the specification. However, the metes and bounds of the term is not clear because specification disclose immunoprecipitation method using protein A and antibody binding to isolate and detect the protein of interest. It is not clear when a method is immunoprecipitation and how the method of the specification differs from the term claimed.

5. Claims 1-5, 7, 12, 23-29, 31, 36, 52-61, 63-68, 70, 75, 91-92 and 122-157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims encompass the terms "wherein said method does not comprise immunoprecipitating said first and second polypeptides" which is new matter not disclosed in the specification. The specification does not disclose the negative subgeneric claim limitation. Applicant indicated that the new claim limitations are supported in the specification on pages 25-29 but the examiner could not find such support.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7, 12, 23-27, 29, 31, 36, 52-54, 91-92 and 122-157 are rejected under 35 U.S.C. 102(b) as being anticipated by McVey et al. (JBC, 2001).

McVey et al. teach a method of detecting human GPCR receptor oligomerization by coexpressing in the same cell and immunoprecipitating the receptors together (pages 14092 and 14094). Immunofluorescent analysis teaches that they are detected in the same cell by microscopy.

Applicants argue that claims encompass "wherein said method does not comprise immunoprecipitating said first and second polypeptides" and thus the rejection does not apply. However, as discussed in the 35 USC 112 second paragraph rejection above, it is not clear that the immunoprecipitating by McVey et al. is different from the method claimed. The rejection is maintained until the metes and bounds of the term is clarified.

7. Claims 1-4, 7, 12, 23-27, 29, 31, 36, 52-61, 63-68, 70, 75, 91-92 and 122-157 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan et al. (Nature, 1999).

Jordan et al. teach a method of detecting human GPCR receptor oligomerization by coexpressing in the same cell different combinations of GPCR and immunoprecipitating the receptors together (pages 697-699). Isolation of cells inherently uses more at least 100 cells.

Applicants argue that claims encompass "wherein said method does not comprise immunoprecipitating said first and second polypeptides" and thus the rejection does not apply. However, as discussed in the 35 USC 112 second paragraph rejection above, it is not clear that the immunoprecipitating by Jordan et al. is different from the method claimed. The rejection is maintained until the metes and bounds of the term is clarified.

8. No claims allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak whose telephone number is 571-272-0879. The examiner can normally be reached on 8:00 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael Pak/
Primary Examiner, Art Unit 1646